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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Willow CSN Incorporated

Serial No. 75/617,596

Leslie J. Lott, Esq. of Lott & Friedland, P.A. for Willow CSN Incorporated.

C. Skye Young, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Chapman, Bucher and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Willow CSN Incorporated (applicant) filed an
application to register the mark CYBERAGENT in typed form
for services ultimately identified as:

employment and career development services, namely
personnel recruitment, training and placement; payroll
and accounting services; and telecommunications
services, namely telemarketing, telephone and
electronic call center services and telephone
answering services in International Class 35; and

educational services and training, namely conducting classes, workshops and seminars in person, by videotape and broadcast and by electronic means in the field of telecommunications services, namely telemarketing, telephone answering services, and telephone and electronic call center services, customer service, computer operation and data processing in International Class 41.

The application (Serial No. 75/617,596) was filed on January 8, 1999, and applicant claimed a date of first use of June 12, 1997, and a date of first use in commerce of September 29, 1998.

The examining attorney¹ initially refused registration on the ground that the mark CYBERAGENT was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because "applicant uses this term in the same descriptive manner, to identify personnel who will be trained to perform the electronic services offered by the applicant." First Office Action, p. 2.

When the examining attorney made the refusal to register final, applicant filed an appeal and a request for reconsideration, including a request for registration under the provision of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). When the request for reconsideration was not successful, this appeal followed.

¹ The current examining attorney was not the original examining attorney in the case.

In support of the refusal, the examining attorney included excerpts of stories retrieved from the NEXIS database.

What Customer Access sells to e-commerce companies is a trained staff of "cyber-agents" ready to take on customer services headaches.
News and Observer (Raleigh, NC), June 10, 1999.

Daimler-Benz, Oracle, and Charles Schwab & Co. are using these cyber-agents to cut call center costs and provide round-the-clock service.
Strategy, March 15, 1999.

US Internet information company Infonautics has unleashed its cyber agents on the job market.
Information World Review, July 1, 1999.

But cyber agents can make extra money selling advertising on their Web sites and selling more lucrative travel packages such as car, hotel, and cruise reservations.
San Francisco Chronicle, September 30, 1997.

"Small agents will perish, especially agents with a reliance on personal lines," he predicted, adding that at the same time, "a new kind of agent will emerge - the on-line agent, the cyber-agent."
National Underwriter, May 13, 1996.

"Cyberagents" at Precision Response Corp. in Miami conduct live chat sessions with customers over the Internet.
St. Petersburg Times, October 18, 1999.

In addition, the examining attorney relied on the dictionary definitions² of "cyber" as "information processor; computer" and "computer network; on-line system" and "agent" as "one that acts or has the power or authority

² *American Heritage Dictionary*, 3rd Edition.

to act" and "one empowered to act for or to represent another." Another definition of "cyber" attached to the Office action dated March 12, 2001, is "From cybernetics, a prefix attached to add to everyday words to add an electronic or online connotation." *Computer Desktop Encyclopedia* (1996). The examining attorney maintained that the combined term "cyberagent" "describes applicant's contractors or agents who use the Internet or a network to conduct their services." Br. at 4-5. Furthermore, the examining attorney was not persuaded by the three declarations, the \$1.5 million in advertising, and the articles in trade and general publications that applicant's mark had acquired distinctiveness. The examining attorney found that the articles submitted by applicant showed "that news sources, in referencing applicant's service, use the proposed mark, "CYBERAGENT," as a descriptive term naming applicant's independent contractors, specifically, and not using the term to identify its services." Br. at 11.

When a client needs to add more agents to their workforce, they set the pay scale for the job and list them on an automated positing program. CyberAgents then select which companies they want to work for ... CyberAgents earn an average from 10 to 14 dollars per hour... In addition, paid company benefits are not required for CyberAgents, they don't get premiums or overtime and the agents provide their own equipment and office (emphasis omitted).

Br. at 11, quoting, C@ll Center CRM Solutions).

Applicant argues that its mark is not merely descriptive "because a consumer cannot readily comprehend the nature of Applicant's educational and career development services simply from seeing the term CYBERAGENT." Br. at 4. Specifically, applicant maintains that the word "'agent' could apply to virtually any worker in general, and therefore, cannot be deemed to refer to Applicant's customer-services in particular." Br. at 5. Because of its many possible meanings, applicant submits that its mark is not descriptive.

Even if the mark is found to be merely descriptive, applicant has submitted evidence to support its assertion that even "if the CYBERAGENT mark could be considered to have been descriptive, the mark has become distinctive of Applicant's services." Br. at 6. Applicant's evidence of acquired distinctiveness consisted of advertising expenditures of approximately \$1.5 million since its inception,³ articles in professional publications, and national recognition.

³ Applicant's general counsel stated in a declaration that applicant has used the mark CYBERAGENT in connection with the applied for services "since I began working with the company in March 1999 and I have no reason to believe that the mark was not being used in connection with classes 35 and 41 at least as early as January 12, 1997." Greif declaration, p. 1. Similarly, Greif declared that the mark has been used in interstate commerce "since I began working with the company in March 1999 and I have no reason to believe that the mark was not being used in

We agree with the Examining Attorney that applicant's mark is merely descriptive and that applicant has not submitted sufficient evidence of secondary meaning. Therefore, we affirm the refusal to register.

THIRD-PARTY REGISTRATIONS AND APPLICATIONS

In its appeal brief, applicant referenced more than 50 marks published in the *Official Gazette*. The references include the date of publication of the mark, the mark, and the goods or services. Applicant then asserts that "because there is a strong policy interest in legal consistency, Applicant respectfully submits a sampling of marks in recent editions of the *Official Gazette* as persuasive evidence that Applicant's mark is entitled to registration." Br. at 9. Not surprisingly, the examining attorney objects to the consideration of these registrations because they "were not properly submitted." Br. at 12. Applicant devotes its Reply Brief to explaining why these marks should be considered. Its primary arguments are that it is not seeking to make registrations of record, it is seeking "to show that many similar marks have been approved for publication for similar goods and

connection with the services in interstate commerce at least as early as September 29, 1998." Id. at 2.

services." Reply Br. at 2. Applicant also argues that the marks were all published after the appeal was instituted.

We will not consider these references to marks published in the *Official Gazette* and presented for the first time in applicant's brief. First, "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board or the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further consideration." 37 CFR § 2.142(d). Obviously, applicant was free to request a remand to have the examining attorney consider this evidence. If a remand were granted, the examining attorney would have the opportunity to submit evidence to rebut the evidence submitted by applicant.

Second, we note that while these marks were published in the *Official Gazette* after the filing of the notice of appeal on November 22, 2000, the case was remanded to the examining attorney to consider applicant's request for registration under the provision of Section 2(f) of the Trademark Act. As late as September 12, 2001, applicant

submitted evidence to the examining attorney. However, applicant failed to include the more than twenty marks that were already published in the *Official Gazette* at that time.

Third, we will not consider these references to marks published in the *Official Gazette* because they are not complete. Applicant has submitted them to show that "similar marks have been approved for publication for similar goods and services." However, by omitting all the data concerning the marks, no such conclusion could be drawn even if the applications were properly of record. Indeed, even a cursory review of these marks would reveal that there are marks registered on the Supplemental Register or under Section 2(f) and there are other marks in which the "Cyber" term has been disclaimed. Other marks are abandoned or otherwise still pending in the Office. While applicant argues that these references are not a "trademark search report" but a representation "by Applicant, through its attorneys" (Reply Br. at 2), we fail to see how this helps applicant. Our case law clearly prohibits what applicant is attempting to do in this case.

In its brief, applicant argues, for the first time, that the Office has registered or published many common, every day phrases. Applicant goes on to list several registrations and applications, contending that the refusal in this application is at odds with

the Office's practice as shown in these other files. The Examining Attorney, in her brief, objected to this evidence because it was not properly made of record. The objection is sustained. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of the appeal, and that the Board will ordinarily not consider additional evidence filed with the Board after the appeal is filed. Moreover, the mere listing of third-party registrations and/or applications is insufficient to properly make them of record. Rather, copies of the official records themselves, or the electronic equivalent thereof, that is, printouts of the registrations taken from the electronic records of the Patent and Trademark Office's own data base, must be submitted. In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 at n.3 (TTAB 1994). Thus, the listing in applicant's brief has not been considered in reaching our decision.

In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1456 n.2 (TTAB 1998). See also In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein").

Finally, the Federal Circuit has held that "[e]ven if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

The cases are legion holding that each application for registration of a mark for particular goods or services must be separately evaluated Section 20

of the Trademark Act...gives the Board the authority and duty to decide an appeal from an adverse final decision of the Examining Attorney. This duty may not be delegated by adoption of conclusions reached by Examining Attorneys on different records. Suffice it to say that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the files of the registered marks and, in any event, the issuance of a registration(s) by an Examining Attorney cannot control the result of another case.

In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994).

DESCRIPTIVENESS

We now analyze the mark to see if it is merely descriptive, and, if so, whether applicant submitted sufficient evidence of acquired distinctiveness. For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 USPQ 505, 507 (CCPA 1980). To be "merely descriptive," a term need only describe a single quality or property of the goods or services. Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor

Dev. Corp., 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978).

In this case, the Examining Attorney relied on several dictionary definitions to explain what the terms in the mark mean. We also take judicial notice of two additional, similar definitions of "cyber." First, it is defined as "a prefix widely used with almost anything these days to indicate an electronic version of something... Cyber- and sometimes just Cyb- has since been used in many contexts from computers to music, as in cybarian, cyberceleb, cyberphile, cyberspace, cybercast, cyperphant, cyberphobe, etc."⁴ The second definition is "A prefix attached to 'everyday' words in order to give them a computer-based or online meaning, as in cyberlaw (the practice of law in relation to or through the use of the Internet) and cyberspace (the virtual online world)."⁵

Applicant's literature demonstrates that applicant provides people to work for companies in an online environment.

CyberAgents supply their own uniquely equipped CyberOffices connected, as required, with each of their clients through the Network's private voice and data system.

⁴ *Data Telecommunications Dictionary* (1999).

⁵ *Microsoft Computer Dictionary, Fifth Edition* (2002).

The CyberAgent Network is a private communications network that provides the exclusive link between the nation's call centers and a national pool of CyberAgents.

The Network's private communication system provides call centers with seamless access to their CyberAgent Pool through high resolution voice and secure data links.

All CyberAgents are members of the National CyberAgent Pool, a cyber work force shared by all client CyberCenters.

It is clear that applicant's services are performed in an online or network environment and, therefore, they would be accurately described as "cyber."

Applicant's literature also shows that the term "agent" (emphasis added) accurately describes its personnel.

The CyberAgent - The Next Evolution of the Home **Agent**.

Conquer 25 Classic Call Center Problems

Now You Have The Choice...

Agents work sporadic shifts - on an as-needed basis...

Agent pool expands by a ratio of 4:1 without added cost...

Professional **agents** to your highest standards...

Costs are lower with professional agents and no on-holds...

Agents are impervious to peer pressure.

Virtual Reality: Willow's Cyber Center Network:

Agents are professionals across the U.S. running their own home businesses... **Agents** could indeed handle outbound campaigns ... **Agent** tech support is largely self-service.

The terms "cyber" and "agent" merely describe representatives of a company that operate in an online

environment. While applicant argues that "a consumer cannot readily comprehend the nature of Applicant's educational and career development services simply from seeing the term CYBERAGENT" (Br. at 4), it is not necessary that a mark be immediately descriptive of all of applicant's services for the term to be merely descriptive. The term would, at least, immediately describe employment and educational services involving applicant's telemarketing, telephone and electronic call center services and telephone answering services. These services include recruiting and training personnel to work as agents for others in an online or "cyber" environment. See, e.g., "a trained staff of 'cyber-agents'"; "using these cyber-agents to cut call center costs"; "Infonautics has unleashed its cyber agents on the job market"; "cyber agents can make extra money selling advertising on their Web sites"; "a new kind of agent will emerge - the on-line agent, the cyber-agent."

Even evidence that applicant has submitted concerning its own operations indicate that the term would be viewed descriptively. Former Vice-President Al Gore referred to applicant's CyberAgent CSR (customer service representatives) as "an occupation that didn't exist a few years ago." *Brickell Post*. In an article entitled "Cyber

agents cash in on latest trend," the article reports that "It's an E-Commerce world and South Florida residents can cash in on the trend by becoming cyber agents and work out of their homes." *Sun-Sentinel Community News* (A photograph with the story is captioned "CYBER AGENT: Sandra Austin, a cyber agent for Willow CSN, takes calls from her home for people shopping on the Internet"). Minnesota AAA, which uses applicant's services, is the focus of an article in a newspaper for call center and customer care professionals entitled "AAA's cyber agent test run scores an A." *CC News*. In that article, it is reported that "[t]he cyber agents scored better in most skills categories than AAA's in-house call takers" and "[h]iring cyber agents has helped AAA reduce its employee churn."

While we consider the individual terms, it is the mark in its entirety that must be considered in determining whether the mark is descriptive. P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 545-46 (1920). However, "[i]t is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof ... provided that the ultimate determination is made on the basis of the mark in its entirety." In re Hester Industries, Inc., 230 USPQ 797, 798 n.5 (TTAB 1986). Here, not only do the individual terms describe applicant's services, but when

the terms are combined we conclude that they result in a term that is merely descriptive. The evidence of the use of the term "cyberagent" or "cyber agent" shows that the variations of this term, when applied to applicant's services, would be recognized by the relevant consumers as a term describing individuals representing an organization that are connected online.

ACQUIRED DISTINCTIVENESS

While we have found that applicant's term is merely descriptive, it would still be registrable on the Principal Register if applicant demonstrates that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act. Nett Designs, 57 USPQ2d at 1565 ("A merely descriptive mark qualifies for registration only if the applicant shows that it has acquired secondary meaning"). Applicant has the burden of proving that its mark has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

Applicant supports its Section 2(f) claim with a declaration that shows that applicant has spent "approximately \$1.5 million [since its inception] on advertising for services related to CYBERAGENT customer services representatives"; "excerpts from local and national publications demonstrating that the public at large and professionals in the call center industry, in particular, identify the CYBERAGENT mark with Applicant"; and three "declarations from experienced call-center professionals." Br. at 6-7.

While we have considered applicant's evidence, we find that it is not enough to meet applicant's burden to show that applicant's mark has acquired distinctiveness. As we pointed out above, many of the references in local and national publications are equivocal at best. They are often likely to create the impression that "cyber agent" is an occupation, not a trademark that identifies applicant's services. "The mere statement of sales volume and advertising expenditures are not persuasive since there is no way of our determining whether these activities have had any impact on purchasers." In re Kwik Lok Corporation, 217 USPQ 1245, 1248 (TTAB 1983). Here, we do not have sales volumes and from the advertising of record, it would not be apparent to many that applicant is using the term

"Cyberagent" as a trademark. See, e.g., "CyperAgents are a uniquely flexible work force who can seamlessly supplement your in-house call-takers"; "All your CyberAgents will be in the top 20% of your call center agents or at your option, we will immediately replace the lesser CyberAgents"; and "CyberAgents are professional call takers who, as independent contractors, work directly for your CyberCenter." Also, the declarations of three customers that state that the mark "uniquely identifies" applicant's services are not sufficient in this case. There is evidence of the common use of the term "cyber agent" descriptively in the online field in general. Even many of the references to applicant appear to use the term descriptively including an article featuring one of applicant's customers whose representative provided a declaration. Finally, we note that even if applicant is the only employment service using the term at issue, this fact would not lead us to conclude that the mark was not merely descriptive. In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993) ("[I]f applicant has been the first and/or, unlike its competitors, is presently the only user of the term "LIGHTWEIGHTS" in connection with shoes, such fact cannot alter the merely descriptive significance of the term").

Therefore, we find that applicant has not met its burden of demonstrating that the mark has acquired distinctiveness with the limited evidence applicant has submitted in this case.

CONCLUSION

In summary, after careful consideration of the relevant authorities and the evidence and arguments of record, we find that the term applicant seeks to register is merely descriptive of services recited in both international classes in the application. Moreover, we find that applicant has failed to submit sufficient evidence of acquired distinctiveness to warrant registration under Section 2(f) of the Trademark Act.

Decision: The refusal to register is affirmed.